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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,350	11/14/2003	Matthew T. Bogosian	A016-P07221US	2397
33356 7590 07/26/2007 SoCAL IP LAW GROUP LLP 310 N. WESTLAKE BLVD. STE 120 WESTLAKE VILLAGE, CA 91362			EXAMINER LEIVA, FRANK M	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/715,350		BOGOSIAN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Frank M. Leiva		3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 45-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 45-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/17/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I claims 1-28 in the reply filed on 23 April 2007 is acknowledged. Also the cancellation of claims 29-44 and additional claims 45-50 filed on 23 May 2007 is acknowledged.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 2 recites the limitation "the game" in the claim. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
5. **Claims 1, 3-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Woolston (US 2002/0116275 A1) herein after Woolston.**
6. Woolston discloses an Internet market system for the commerce of goods and services outside a gaming environment.  
**Claim 1:** Woolston discloses displaying an offer from a first user (i.e., the seller) for changing ownership of an item, wherein the offer specifies one or more conditions, and receiving an acceptance of the one or more conditions (i.e., price) in the offer from a second user (i.e., the buyer), wherein the first user is the owner of the item,

(¶0027). Upon acceptance of the one or more conditions, Woolston discloses changing the ownership of the item from the owner to the other of the first user and the second user outside the game environment, (¶0028).

**Claim 3:** Woolston discloses determining if the item is already subject to another offer, (¶0060:33-36).

**Claim 4:** Woolston teaches informing the owner that the item is already subject to another offer, by posting to all electronic auction participants (i.e. the owner and buyers), (¶0032).

**Claims 5, 6, 10:** The offer is a sale, trade, or auction, (¶0011, ¶0027 & ¶0029).

**Claim 7:** Receiving a price for the item as a condition, (¶0027).

**Claim 11:** Receiving information regarding the auction may be a condition of the offer, (¶0011 & ¶0029).

**Claims 8 & 9:** Wherein the offer is a trade, and further comprising receiving identification of one or more items for the trade as a condition, (¶0012).

**7. Claims 18-28 & 45-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Martinez et al (US 6,119,229) herein after Martinez.**

**8. Martinez discloses a system of persistent virtual items in an Internet gaming environment wherein a method of lending by changing possession of items outside a game environment without changing ownership.**

**Claim 18:** A method of changing possession of items outside a game environment without changing ownership, (Col. 14:41-57); Displaying an offer from a first user to loan or borrow an item without changing ownership; wherein the offer specifies one or more conditions; receiving an acceptance of the one or more conditions in the offer from a second user; wherein one of the first user and the second user is an owner of the item; and upon acceptance of the one or more conditions, allowing use of the item by a borrower, (Col. 13:29- Col. 14:57); Receiving an acceptance of the one or more conditions in the offer from the second user where one of the users is

an owner of the item, (Col. 13:29- Col. 14:57); upon acceptance of the one or more conditions, allowing use of the item by the borrower, (Col. 13:29- Col. 14:57); and wherein the borrower is the first user if the offer was to borrow or the second user if the offer was to lend, (Col. 13:29- Col. 14:57).

**Claim 19:** Storing information about the item in data structures maintained separately from the game that utilizes the item, (Col. 14:41-57).

**Claim 20:** Determining if the item is already subject to another offer, (Col. 13:29- Col. 14:18). Brokering rules.

**Claim 21:** Informing the owner that the item is already subject to another offer, (Col. 13:29- Col. 14:18). Brokering rules.

**Claim 22:** Wherein a limitation on the borrower to effect the item is specified, (Col. 14:41-57). The user may not take the borrowed item out of play.

**Claims 23-25:** Wherein the offer is a loan; receiving the duration of the loan as a condition; and changing the possession of the item to the owner outside the game environment when the duration of the loan expires, (Col. 14:41-57). As martinez points to borrowing/lending, duration and expiration limitations are inherent in lending.

**Claims 26-28:** Wherein the offer is a lease; receiving a duration of the lease as a condition; and receiving a periodic payment amount of the lease as a condition, (Col. 14:41-57). Leasing, another form of borrowing and lending, inherently comes with duration of contracts and repetitive payments.

**Claim 45:** Storing information about the item on an asset server (i.e., the transactor server) separate from a client or server executing the game that utilizes the item, (Col. 14:41-57).

**Claim 46:** Providing an API, wherein the API is called by the client or server executing the game that utilizes the item, (Fig. 1, Col. 14:45-57). The API is inherent to all communications between game server and Transactor, and the game server takes ownership of the item during the game means it called out to the Transactor and acquired the object.

**Claim 47:** Creating an exclusive lock on the item upon request from the client or server executing the game, (Col. 26:53-56). Assignment of an item locks the use of the item to only the owner for trading only by the owner's permission.

**Claim 48:** Wherein storing information includes storing information defining the owner of the item, (Col. 26:42-52).

**Claim 49:** Wherein storing information includes storing information defining the terms of a transaction for the item, (Col. 26:42-52).

**Claim 50:** Wherein storing information includes storing the locked or unlocked state of the item, (Col. 26:42-52).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 2 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston as applied to claim 1 above in view of Martinez.**

11. **Regarding claims 2 & 12; Woolston discloses all the limitations recited in claim 1 from which claims 2 and 12 depend. Woolston is silent of the fact that the items for sale are used in an actual game. Martinez discloses virtual property and the exchange of the this property outside the gaming environment by storing information about the items in data structures maintained separately from the game that utilizes the item, and storing information about the item on an asset server separate from a client or server executing the game that utilizes the item, (Col. 5:64-Col. 6:4).**

**12. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Martinez as applied to claims 1 & 2 above.**

Woolston is silent on items used in games, and explicit interactions with game servers.

Martinez discloses a virtual property system of persistent items amongst gaming platforms;

**Claim 13:** Providing an API, (Application Program Interface), wherein the API is called by the client or server executing the game that utilizes the item, (Fig. 1, Col. 26:31-41).

**Claim 14:** Creating an exclusive lock on the item upon request from the client or server executing the game, (Col. 26:54-56).

**Claim 15:** Wherein storing information includes storing information defining the owner of the item, (Col. 26:42-52).

**Claim 16:** Wherein storing information includes storing information defining the terms of a transaction for the item, (Col. 26:42-52).

**Claim 17:** Wherein storing information includes storing the locked or unlocked state of the item, (Col. 26:54-56).

**13.** It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston's internet market invention with Matinez's persistent virtual property trading invention and incorporate all the features related to the virtual property exchanges to allow commerce and competition for market share in which to trade virtual goods. The benefits of facilitating this trade would be apparent to one of ordinary skill in the art.

#### ***Citation of Prior Art***

**14.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ellis et al (US 2004/0015608 A1), dynamic incorporation of advertising content. Rothschild et al (US 6,152,824), online gaming architecture. Hawkins et al (US 6,009,458), computer gaming system with persistent playing objects. Morrow et al (US 2004/0054952 A1), verification system over the Internet. Rubin, (US 4,840,382), financial asset games.

Art Unit: 3714

**Conclusion**

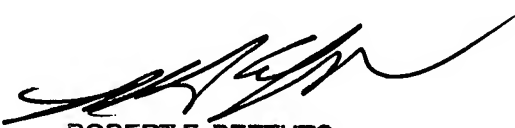
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Leiva whose telephone number is (571) 272-2460. The examiner can normally be reached on M-Th 8:30am - 5:pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

07/19/2007

  
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SUPERVISORY PRIMARY EXAMINER